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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/678,118

10/06/2003

Lee Salzmnn

REM-101

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CAPITAL LEGAL GROUP, LLC

1100 River Bay Road

Annapolis, MD 21409

EXAMINER

AUGUSTIN, EVENS J

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

09/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/678,118 | Applicant(s) SALZMANN ET AL. | |
| | Examiner EVENS J. AUGUSTIN | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement

1. On 15 October 2007, the USPTO inadvertently sent a final and a non-final office action to applicant. On 19 May 2008, applicant responded to the non-final office action, rendering the advisory action sent on 14 July 2008 to be premature. Claims 26-103 are pending.

Claim Rejections - 35 USC §101

2. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 22-77 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

4. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.² If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

5. In this particular case, method 26 claim, for example, is not tied to any to another statutory class (such as a particular apparatus), is therefore non-statutory.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26-103 rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonald et al (U.S. PG Pub No. 2004/0019558) in view of Messing (U.S. Patent No 7,039,805).

8. As per claims 26, 31-34, MacDonald et al teach a method of using a computer system to facilitate a real estate transaction comprising receiving real estate transaction information for the real estate transaction (such as sale of property, estate financing, insuring property, sale of mortgage), outputting a preliminarily compiled at least one form electronic document to be used in the real estate transaction, wherein the form is compiled with at least some of the real estate transaction information; receiving a digitally scanned image of at least one ancillary document, and outputting the at least one ancillary document in conjunction with a finally compiled said preliminary compiled at least one form electronic document integrating a signature into said preliminary compiled at least one form electronic document (*see figs 3, paragraphs 0015, 0031, 0032, 0033, 0073, 0091-0271*). MacDonald et al fail to teach receiving an electronic signature indicating approval of the preliminarily compiled at least one form electronic document. However, Messing teaches receiving an electronic signature indicating approval of the

preliminarily compiled at least one form electronic document (*see column 2 lines 5-35, 3 line 55-4 line 26*). Therefore, it would have been to one of ordinary skill in the art at the time the invention was made to modify the MacDonald et al's inventive concept to include Messing's invention of receiving an electronic signature indicating approval of the preliminarily compiled at least one form electronic document because this would have created a more agile system.

9. As per claims 27-30 and 35-41, MacDonald et al teach a method wherein the real estate transaction information is party information identifying a party (buyer, a seller, a borrower, a lender, a mortgage investor) and (the property, financial information such as loan) related to the real estate transaction and wherein the signature integrated into the finally compiled at least one form document is a handwritten signature (*see figs 3, paragraphs 0015, 0031, 0032, 0033, 0073, 0091-0271*).

10. As per claims 42-103, the disclosed the same inventive concept as claims 26-41 and their limitations are fully taught in MacDonald disclosure. Therefore, they are rejected under the same rationale.

Conclusion

1. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end

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of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EVENS J. AUGUSTIN whose telephone number is 571-272-6860. The examiner can normally be reached on 10am - 6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571)272-677979.

/Evens J. Augustin/
Evens J. Augustin
October 7, 2007
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